

**REMARKS**

The Examiner has rejected claims 1 and 3 – 7 under 35 U.S.C. §103(a) as being unpatentable over Coates (US Patent 5,059,196) in view of Vinciguerra et al. (US Patent 5,554,158).

The primary reference to Coates discloses two embodiments of femoral prosthesis holders, neither of which disclose or suggest the invention set forth in claims 1 and 3 – 7 whether taken alone or in combination with reference to Vinciguerra. Coates discloses a shaft 26 (referred to as by the Examiner as “housing”) having a threaded portion 52 with an enlarged smooth cylindrical portion 68 which fits into an aperture 62 of the bracket 60. The Examiner states that “The flange and post are capable of being rotated (see top of Fig. 1) that are capable of obtaining at least two orientations, enabling a condylar engagement to be attached to a first and second condylar portions”. Claim 1 has been amended to clearly set forth the feature of the “... post and flange being rotatable together about said longitudinal axis ...” It is believed that this clearly distinguishes the present invention over Coates whether taken alone or in combination with Vinciguerra. Although the post 26 of Coates may be rotatable, it is clear that the pair of arms 72, 74 with their prosthesis gripping fingers 80, 82 are not and could not be rotatable about the longitudinal axis of the shaft 26. In the first place, the arms 72, 74 and their respective lateral 80 and medial 82 fingers are sized such that they

can be inserted into the space between the pads 64, 66 and also into the notch 14 between the opposing sections of the internal distal retaining wall 84 of the prosthesis 12. In other words in the intercondylar notch 14 between the medial 22 and lateral 24 portions of the condylar flange. The arms 72, 74 are attached by and pivot about pins 75. The arms 72, 74 receive a complimentary wedge portion 71 located at the distal end 40 of the shaft 26 (see Figs. 1 and 5) which wedge portion 71 causes the arms 72, 74 to spread outwardly at their distal ends and move the lateral 80 and medial 82 fingers outwardly into position to grip the internal distal end retaining wall 84 of the prosthesis as impact pads 64, 66 exert an opposite pressure against the external surface of the distal condyle 59 (see column 5, lines 27 – 32).

As clearly pointed out in the specification of Coates, the distance between the ends of the fingers 80, 82 is less than the distance between the interior edges of the condyles 16, 18 of the prosthesis in order to permit the arms 72, 74 and fingers 80, 82 to be installed in the space between the pads 64, 66 and to extend through the intercondylar notch 14 preparatory to being manipulated to engage the internal wall 84 surround the notch 14 of the prosthesis. (See col. 5, lines 1 – 4.)

Accordingly, there is no reason whatsoever that the arm 72, 74 should rotate about the longitudinal axis of the shaft 26. It is also clear that the arms 72, 74 could not rotate about the longitudinal axis of the shaft. As noted in Fig. 1, the

springs 122 are positioned to urge the arms 72, 74 to their closest together position as shown in Fig. 1 in order that they and their fingers 80, 82 can be inserted between the impact pads 64, 66. The presence of such springs 122 urging against the arms 72, 74 makes it clear that such arms 72, 74 could not rotate about the longitudinal axis. (See col. 6, lines 39, 40.)

The other embodiment of Coates set forth in Figs. 3, 4, 8 and 9 utilizes a unitary arm 36 mounted on a rectangular base 42. The arm 36 has a gripping finger 38 which grips the internal contact surface 20 in the area between the condyles of the prosthesis. As pointed out at column 6, lines 48, 49, "Because no medial or lateral fingers are formed on the arm 36, no gripping of the internal distal retaining wall 84 occurs." This coupled with the fact that the base 42 and arm 36 are rectangular and sized to closely fit in the space between the pads 64, 66 clearly shows that the base 42 and arm 36 could not be rotatable about the longitudinal axis of the shaft 26.

The reference to Vinciguerra is simply a notch cutter in which a bit 12 supported by guide sleeve 14 extends through a hollow cylindrical shaft 32 which serves both as a handle and as support for the bit. The comments with respect to this reference which were set forth in the Response filed April 12, 2007, are incorporated herein.

Reviewing claim 1, it is respectfully submitted that the combination of

Coates and Vinciguerra et al. do not disclose or suggest a post having an outwardly extending flange at its distal end, which post and flange are rotatable together about the longitudinal axis of the post. Such references also do not disclose or suggest a flange which has (1) first and second edges spaced apart to define a breadth smaller than the gap between the inner edges of the condylar portions of the prosthesis and (2) first and second ends spaced apart to define a length which is greater than the gap between the inner edges of the condylar portions of the prosthesis and which thereby engage the superior side of such condylar portions upon rotation along with rotation of the post.

With respect to claims 4 and 5, there is no teaching in the references of means to prevent rotation of the post in the housing or of a longitudinally extending slot in the post and an abutment extending into the slot to permit axial movement of the post while preventing rotation of it in the housing.

With respect to claims 6 and 7, the references similarly do not show or suggest a slot at the proximal end of the handle for receiving a tool.

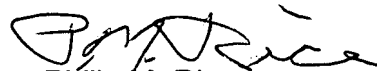
To establish a *prima facie* case of obviousness, the Examiner must, *inter alia*, show "some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." In re Thrift, 298 F.3d 1357, 1363, 63 USPQ2d 2002, 2006 (Fed.Cir. 2002). "When the references cited by the examiner

fail to establish a *prima facie* case of obviousness, the rejection is improper and will be overturned." In re Brouwer, 77 F3d 422, 425, 37 USPQ2d 1663, 1666 (Fed.Cir. 1996). It is respectfully submitted that no *prima facie* case for obviousness can be made with respect to claims 1 and 3 – 7 based upon the combination of references cited, namely, Coates and Vinciguerra.

In view of the foregoing, reconsideration of the application and allowance of claims 1 and 3 – 7 are respectfully solicited. The allowance of claims 15 – 19 is noted with appreciation.

Respectfully submitted,

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